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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,028	03/05/2002	Robert Degen	20375-003210	7763
20350 7590 02/27/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/092,028	DEGEN ET AL.	
	Examiner	Art Unit	
	Sara Chandler	3693	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/09/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/09/03</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

Applicant's election without traverse of claims 1-12 in the reply filed on 01/09/07 is acknowledged.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4** are rejected under 35 U.S.C. 102(e) as being anticipated by Busuioc, US Pat. No. 6,212,266.

**Re Claim 1:** Busuioc discloses a method for evaluating transactions for suspicious activity, the method comprising:

providing a reference designator list, wherein the reference designator list includes at least a subset of information available from a first transaction system that is associated with suspicious activity (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6);

evaluating a first transaction associated with the first transaction system using the reference designator list to detect suspicious activity (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6); and

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evaluating a second transaction associated with a second transaction system using the reference designator list to detect suspicious activity (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6).

**Re Claims 2 and 4:** Busuioc discloses the method, wherein the subset of information is a first subset of information, the method further comprising:

receiving a second subset of information from the first transaction system (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6); and

incorporating the second subset of information into the reference designator list (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6).

**Re Claim 3:** Busuioc discloses the method, the method further comprising:

receiving a third subset of information from the second transaction system (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6); and

incorporating the third subset of information into the reference designator list (Busuioc, Fig. 1, abstract, col. 1, lines 10-39; col. 2, lines 65+ - col. 2, line 47; col. 3, line 10 – col. 4, line 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 5,6,7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Busuioc, US Pat. No. 6,212,266.

**Re Claims 5,6,7 and 8:** Busuioc discloses the claimed method supra and Busuioc fails to explicitly disclose, wherein the second subset of information comprises: a telephone number; credit card number; a name; or an address. Official Notice is taken that it is old and well-known in businesses engaged in commercial or financial transactions to collect information that can serve as an identifier of authorized or unauthorized accounts and users. Specifically, it was old and well-known to provide, wherein the second subset of information comprises: a telephone number; credit card number; a name; or an address. For example, banks commonly use a combination of identifiers such as card numbers, account numbers, PIN numbers or social security numbers to verify that the account is being accessed by an authorized user rather than a user engaged in unauthorized uses such as fraud and identity theft. For example, many companies engaged in customer service or billing will request a series of identifiers such as name, telephone number, address, account number or e-mail address to similarly distinguish

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authorized versus unauthorized users. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Busuioc to further provide, wherein the second subset of information comprises: a telephone number; credit card number; a name; or an address. One would have been motivated to use common and well-known identifiers to aid in security, customer service and processing transactions.

**Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Busuioc, US Pat. No. 6,212,266 in view of Justice, US Pat. No. 6,516,056.

**Re Claim 9:** Busuioc discloses the claimed method supra and Justice further discloses, wherein the first transaction system is a system for analyzing authorization requests, and wherein the authorization request is received via a telephone call (Justice, Fig. 3, abstract; col. 1, lines 10-20; col. 3, line 54+ - col. 4, line 25; col. 6, line 58+ - col. 7, line 30).

**Claims 10,11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Busuioc, US Pat. No. 6,212,266 in view of Justice, US Pat. No. 6,516,056 and Curtis US, US Pat. No. 6,208,720.

**Re Claim 10:** Busuioc discloses the claimed method supra but fails to explicitly disclose, wherein the first transaction system::  
receives an authorization request at a receiving center, wherein the authorization request is associated with a request to charge a credit account;  
determining an origin of the authorization request; and

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comparing the origin of the authorization request with the information point in the reference designator list.

Justice discloses, wherein the first transaction system:: receives an authorization request at a receiving center, wherein the authorization request is associated with a request to charge a credit account (Justice, abstract; col. 4, lines 20-24; col. 6, lines 24-38; col. 8, lines 53-54; col. 6, lines 60-61).

Curtis discloses: determining an origin of the authorization request (Curtis, abstract; col. 1, lines 49-57; col. 10, lines 12-24; col. 11, lines 60+ - col. 12, line 5; col. 14, lines 10-40); and comparing the origin of the authorization request with the information point in the reference designator list (Curtis, abstract; col. 1, lines 49-57; col. 10, lines 12-24; col. 11, lines 60+ - col. 12, line 5; col. 14, lines 10-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Busuioc by adopting the teachings of Justice and Curtis to provide a method further comprising, wherein the first transaction system: receives an authorization request at a receiving center, wherein the authorization request is associated with a request to charge a credit account; determining an origin of the authorization request; and comparing the origin of the authorization request with the information point in the reference designator list.

As suggested by Curtis, one would have been motivated to process records such as telecommunications records in order to detect patterns of fraudulent activity.

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**Re Claims 11 and 12:** Busuioc discloses the claimed method supra but fails to explicitly disclose, wherein the first transaction system:  
receives an authorization request at a receiving center, wherein the authorization request is associated with a request to charge a credit account;  
determining an origin of the authorization request;  
investigating the origin of the authorization request, wherein it is determined that the authorization request is suspicious; and  
providing the origin of the authorization, wherein the origin of the authorization comprises at least a portion of the subset of information and is incorporated into the reference designator list.

Justice discloses the method, wherein the first transaction system:  
receives an authorization request at a receiving center, wherein the authorization request is associated with a request to charge a credit account (Justice, abstract; col. 4, lines 20-24; col. 6, lines 24-38; col. 8, lines 53-54; col. 6, lines 60-61).

Curtis discloses:  
determining an origin of the authorization request (Curtis, abstract; col. 1, lines 49-57; col. 10, lines 12-24; col. 11, lines 60+ - col. 12, line 5; col. 14, lines 10-40);  
investigating the origin of the authorization request, wherein it is determined that the authorization request is suspicious (Curtis, abstract; col. 1, lines 49-57; col. 10, lines 12-24; col. 11, lines 60+ - col. 12, line 5; col. 14, lines 10-40); and  
providing the origin of the authorization, wherein the origin of the authorization comprises at least a portion of the subset of information and is incorporated into the



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reference designator list (Curtis, abstract; col. 1, lines 49-57; col. 10, lines 12-24; col. 11, lines 60+ - col. 12, line 5; col. 14, lines 10-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings Busuioc by adopting the teachings of Justice and Curtis to provide wherein the first transaction system: receives an authorization request at a receiving center, wherein the authorization request is associated with a request to charge a credit account; determining an origin of the authorization request; investigating the origin of the authorization request, wherein it is determined that the authorization request is suspicious; and providing the origin of the authorization, wherein the origin of the authorization comprises at least a portion of the subset of information and is incorporated into the reference designator list.

As suggested by Curtis, one would have been motivated to process records such as telecommunications records in order to detect patterns of fraudulent activity.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Bowman, US Pat. No. 5,627,886- fraud;

Degen, US Pat. No. 6,254,000- fraud;

Marchand, US Pat. No. 6,947,532- fraud; and

McAllister, US Pat. No. 5,655,007.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

  
JAGDISH N. PATEL  
PRIMARY EXAMINER

2/16/07